

REMARKS

The present application has been reviewed in light of the Office Action dated July 30, 2009. Claims 1, 2, and 5-9, 16, 20, 23-28 are presented for examination, of which Claims 1, 10, 16, 23, 25, 26, and 28 are in independent form. Claims 10-15, 17-19, 21, and 22, have been canceled, without prejudice or disclaimer of subject matter, and new Claims 23-28 have been added to provide Applicants with a more complete scope of protection. Claims 1, 5-7, and 16 have been amended to define aspects of Applicants' invention more clearly. Favorable reconsideration is requested.

The Office Action rejects Claims 1, 2, 7, 8, 10, 13, and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,157,706 (*Rachelson*) in view of U.S. Patent Application Publication No. 2002/0075524 (*Blair et al.*), U.S. Patent No. 6,097,797 (*Oseto*), and U.S. Patent No. 6,687,742 (*Iwazaki*); rejects Claims 5, 12, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Rachelson* in view of *Blair et al.*, *Oseto*, *Iwazaki*, and U.S. Patent No. 6,658,456 (*Shimoosawa*); rejects Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Rachelson* in view of *Blair et al.*, *Oseto*, *Iwazaki*, and U.S. Patent No. 6,721,783 (*Blossman et al.*); rejects Claims 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Rachelson* in view of *Blair et al.*, in view of *Oseto*, *Iwazaki*, and U.S. Patent No. 6,883,016 (*Fujii et al.*); and rejects Claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Rachelson* in view of *Blair et al.*, *Oseto*, *Iwazaki*, and U.S. Patent No. 6,356,356 (*Miller et al.*). Cancellation of Claims 10-15, 17-19, 21, and 22 renders their rejections moot. For at least the following reasons, Applicants traverse these rejections and submit that independent Claims 1, 10, 16, 23, 25, 26, and 28, together with the claims dependent therefrom, are patentably distinct from the cited prior art.

The aspect of the present invention set forth in Claim 1 is a communication apparatus. The communication apparatus includes registration means, reception means, confirming means, transmission means, and generating means. The registration means registers electronic mail accounts of clients via a first network upon receiving requests from the clients. Each of the requests includes a customized format of an image to be received. The reception means receives facsimile data from a second network that uses a different communication protocol from the first network. The facsimile data includes color image information and/or monochrome image information. The confirming means confirms whether each of the clients maintains a valid account. The generating means generates electronic mails directed to the electronic mail accounts of the clients. Each of the electronic mails has an attachment generated based on the received facsimile data having the color image information and/or monochrome image information received by the reception means, and also based on the customized format for each of the clients registered by the registration means. The transmission means transmits the electronic mails generated by the generating means to the electronic mail accounts of the clients.

Notably, the generating means generates the electronic mails based on the customized format including, in a first case, information regarding dividing the received facsimile data into several pages to create one file from each page, and, in a second case, information regarding grouping all pages of the received facsimile data into a single file, for attachment to a single electronic mail for at least one of the clients. By virtue of the operation of the generating means, the received facsimile data can be transmitted to a first client in a first format, based on the customized format registered for the first client, and can be transmitted to a

second client in a second format, based on the customized format registered for the second client, for example.¹

Rachelson is understood to relate to an apparatus for enabling a facsimile machine to behave as an e-mail client (*see* col. 1, lines 6-8). *Rachelson* discusses that a received fax message can be converted to a graphics file before sending the graphics file as an e-mail (*see* col. 11, lines 21-23). A graphics format that is preferred by a recipient can be stored in a recipient database and the graphics file can be converted to the format preferred by the recipient (*see* col. 11, lines 21-23). Nothing has been found in *Rachelson* that teaches or suggests that the received fax message is converted to a format in which a file is created for each page of the fax message.

Blair et al. is understood to relate to desktop image acquisition peripheral devices that automatically acquire and transfer images for transporting (*e.g.*, via e-mail), editing, processing, archiving, copying, and printing (*see* paragraph 2). Nothing has been found in *Blair et al.* that is deemed to remedy the deficiencies of *Rachelson* discussed above.

Oseto is understood to relate to a network facsimile apparatus that generates a sub-address that is uniquely related to an electronic mail address of a client terminal (*see* col. 1, lines 8-11). Nothing has been found in *Oseto* that is deemed to remedy the deficiencies of *Rachelson* discussed above.

Iwazaki is understood to relate to a communication control method for an electronic mail system in which a plurality of electronic mail devices transmit and receive images in electronic mail over a computer network (*see* col. 1, lines 14-18). *Iwazaki* discusses that a scanner section 27 scans an original and an image processing section 29 generates binary compressed data with fixed parameters (*see* col. 11, lines 19-26). An e-mail generator 25

¹ Any examples presented herein are intended for illustrative purposes and are not to be construed to limit the scope of the claims.

generates “an identification-information added image file of specific conditions” and converts the image file to e-mail data to generate an e-mail message (*see* col. 11, lines 27-30). That is, “an image file” is generated according to a TIFF format defined by RFC 2301 (*see* col. 11, lines 31 and 32). A TIFF data structure includes a header followed by a plurality of Image File Directories (IFD), which indicate information of each page, and image data for each page (*see* col. 11, lines 32-35). As best understood by Applicants, the e-mail generator 25 generates a single image file that includes the TIFF data structure, which includes image data for each page of the original. Nothing has been found in *Iwazaki* that teaches or suggests that the e-mail generator 25 generates a plurality of image files, each of which includes image data for one of the pages of the original.

In summary, Applicants submit that a combination of *Rachelson, Blair et al.*, *Oseto*, and *Iwazaki*, whether considered separately or in combination, assuming such combination would even be permissible, would fail to teach or suggest a communication apparatus that includes “generating means for generating a plurality of electronic mails directed to the electronic mail accounts of the clients, wherein each of the electronic mails has an attachment generated based on the received facsimile data having the color image information and/or monochrome image information received by said reception means, and also based on the customized format for each of the clients registered by said registration means,” and wherein “the generating means generates a plurality of electronic mails based on the customized format including, in a first case, information regarding dividing the received facsimile data into several pages to create one file from each page, and, in a second case, information regarding grouping all pages of the received facsimile data into a single file, for attaching to a single electronic mail for at least one of the clients,” as recited in Claim 1.

Accordingly, Applicants submit that Claim 1 is patentable over the cited art, and respectfully request withdrawal of the rejection of Claim 1 under 35 U.S.C. § 103(a). Independent Claim 16 includes features sufficiently similar to those of Claim 1 that Claim 16 is believed to be patentable over the cited art for at least the reasons discussed above.

The aspect of the present invention set forth in Claim 23 is an image communication apparatus that performs facsimile communications through the Internet. The image communication apparatus includes a registration unit, a reception unit, and a transfer unit. Notably, the registration unit registers an E-mail address to be received, an E-mail address of a transfer destination, and transfer content including an indication that transfer of an E-mail body is unnecessary and transfer of an attached file is necessary. The reception unit receives the E-mail body and the attached file using an Internet facsimile procedure. Also notable is that the transfer unit selects the E-mail body or the attached file received by the reception unit and transfers the selected E-mail body or the selected attached file to the E-mail address of the transfer destination registered by the registration unit, according to the transfer content registered by the registration unit. By virtue of the operation of the registration unit and the transfer unit, a file attached to a received E-mail can be transmitted without the body of the E-mail body, for example.

Applicants submit that the cited art, whether considered separately or in combination, fails to teach or suggest an image communication apparatus that includes “a registration unit configured to register an E-mail address to be received, an E-mail address of a transfer destination, and transfer content including an indication that transfer of an E-mail body is unnecessary and transfer of an attached file is necessary,” and “a transfer unit configured to select the E-mail body or the attached file received by the reception unit and transfer the selected

E-mail body or the selected attached file to the E-mail address of the transfer destination registered by the registration unit, according to the transfer content registered by the registration unit," as recited in Claim 23. Accordingly, Applicants submit that Claim 23 is patentable over the cited art. Independent Claim 26 includes features sufficiently similar to those of Claim 23 that Claim 26 is believed to be patentable over the cited art for at least the reasons discussed above.

The aspect of the present invention set forth in Claim 25 is a communication terminal apparatus that performs facsimile transmission and reception through a public network and is connected to a plurality of clients through a local area network (LAN). The communication terminal apparatus includes a reception unit, a registration unit, a judgment unit, an electronic mail creation unit, and a transmission unit. The reception unit receives images by facsimile communications through the public network. The registration unit registers registration information that includes information indicating how to convert the images received by the reception unit, in correspondence with electronic mail addresses of clients of transmission destinations, and indicating whether to attach files when transmitting electronic mails, and information indicating whether the files include all or a part of the images received by the reception unit. The judgment unit judges whether a client of a transmission destination has been registered by the registration unit. If the client of the transmission destination is judged to be registered by the registration unit, the electronic mail creation unit creates an electronic mail based on the registration information. If the registration information corresponding to the client indicates that a file is to be attached to the electronic mail, the electronic mail creation unit converts an image received by the reception unit into the file and attaches the file to the electronic mail. The transmission unit transmits the electronic mail, to which the file has been

attached, to the client of the transmission destination. By virtue of the operation of the registration unit and the electronic mail creation unit, the communication terminal apparatus can determine whether the client should receive electronic mail that includes an attached file, and whether the attached file, if any, includes all or part of an image received by the reception unit, for example.

Applicants submit that the cited art, whether considered separately or in combination, fails to teach or suggest a communication terminal apparatus that includes “a registration unit configured to register registration information that includes information indicating how to convert the images received by the reception unit, in correspondence with electronic mail addresses of clients of transmission destinations, and indicating whether to attach files when transmitting electronic mails, and information indicating whether the files include all or a part of the images received by the reception unit,” and “an electronic mail creation unit configured to, if the client of the transmission destination is judged to be registered by the registration unit, create an electronic mail based on the registration information, and, if the registration information corresponding to the client indicates that a file is to be attached to the electronic mail, convert an image received by the reception unit into the file, and attach the file to the electronic mail,” as recited in Claim 25. Accordingly, Applicants submit that Claim 25 is patentable over the cited art. Independent Claim 28 include features sufficiently similar to those of Claim 25 that Claim 28 is believed to be patentable over the cited art for at least the reasons discussed above.

The other claims in the present application depend from one or another of independent Claims 1, 23, and 26 and are submitted to be patentable for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the

invention, however, individual consideration or reconsideration, respectively, of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and an early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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